

REMARKS

Status of the Application

Claims 1-20 were pending in the application at the time the Office Action was mailed. All claims have been rejected. No claims have been added. Claims 1-3, 12, 17, 19, and 20 have been amended. Therefore, claims 1-20 remain pending and before the examiner for consideration.

Attorney Docket Number

Applicant requests that the attorney docket number for the present application be updated to reflect the current attorney docket number of 9751-1.

Rejections Under 35 U.S.C. 103

Claims 1-4, 12-13 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,523,090 to Znaiden and WO 94/15626 (WO). According to the Office Action:

WO teaches a cosmetic composition comprising Vismia extract, which is used for promoting collagen synthesis, particularly for skin aging or enhancing skin firmness (abstract). WO does not a combination of the claimed components of the treatment of hyperpigmentation with Vismia.

Znaiden teaches skin treatment composition for improving skin strength and firmness and reducing signs of cellulite. The composition contains xanthine, inositol phosphoric acid (also known as phytic acid). According to Znaiden the composition provides a treatment for cellulite by improving the appearance of skin by increasing skin strength, firmness and elasticity (col. 5, L 64-67). Thus, both WO and Znaiden teach skin compositions that are effective for skin care such as skin firmness, collagen synthesis etc., in the claimed amounts and therefore combination of the teachings of WO and Znaiden flows logically. Znaiden also suggests adding other skin benefit agents such as moisturizers, skin lighteners etc. (col. 6, L 49-62) to the composition containing phytic acid. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to combine Vismia (WO) and phytic acid (of Znaiden), both of which are

effective for improving skin firmness. One of an ordinary skill in the art would have expected to provide enhanced skin firmness with the combination of phytic acid and Vismia extract.

Claims 1-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,523,090 to Znaiden in view of JP 200351722 (JP '722), and WO 94/15626 (WO).

Znaiden teaches skin treatment composition for improving skin strength and firmness and reducing signs of cellulite. The composition contains xanthine, inositol phosphoric acid (also known as phytic acid). According to Znaiden the composition provides a treatment for cellulite by improving the appearance of skin by increasing skin strength, firmness and elasticity (col. 5, L 64-67). Znaiden does not teach Vismia, kojic acid and arbutin and also fail to teach the claimed method of treating hyperpigmentation. However, Znaiden also suggests adding other skin benefit agents such as moisturizers, skin lighteners etc., (col. 6, L 49-62) to the composition containing phytic acid.

JP '722 (abstract only) teaches a skin-lightening and moisturizing composition comprising green algae extracts, melanin formation inhibitors or inflammation inhibitors. Among the melanin formation inhibitors (skin-lightening agents), JP teaches kojic acid and arbutin, both of which are claimed in the instant application.

WO teaches a cosmetic composition comprising Vismia extract, which is used for promoting collagen synthesis, particularly for skin aging or enhancing skin firmness. WO does not a combination of the claimed components of the treatment of hyperpigmentation with Vismia. It would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to include Vismia of WO and kojic acid and arbutin of JP in the composition of Znaiden because JP suggests kojic acid and arbutin as skin lightening agents and WO suggests Vismia for skin firmness, collagen synthesis, which also impart smoothness to skin.

According to instant claims Vismia and phytic acid are not required to be effective anti-pigmentation agents and therefore, the combination of Znaiden with JP and WO results in a composition effective in melanin inhibition (skin lightening agents) due to kojic acid, arbutin and effective in skin firming due to phytic acid and Vismia.

Applicants submit that the combination of references does not teach all the claim limitations present in amended independent claims 1 (from which claims 2-10 depend), 11, 12

(from which claims 13-15 depend), and 16-20. As amended herein, claim 1 recites a "topical composition comprising a mixture of vismia in an amount effective to lighten skin and phytic acid in an amount effective to lighten skin." Independent claims 11, 12, and 16-20 all recite compositions including vismia and phytic, each in an amount effective to lighten skin. None of Znaiden, WO 94/15626 and JP 200351722 teach the limitation of "vismia in an amount effective to lighten skin," nor do any of these references teach the limitation of "phytic acid in an amount effective to lighten skin." Instead, Znaiden teaches using phytic acid for treating cellulite and skin whitening agents such as ferulic acid or kojic acid. WO 94/15626 teaches using vismia for promoting collagen synthesis, while JP 200351722 teaches skin-lightening cosmetics containing kojic acid and arbutin. None of these references teach using phytic acid or vismia for lightening skin, only for promoting collagen synthesis and reducing cellulite, two functions that have nothing to do with skin lightening. The examiner acknowledges on page 4 of the Office Action that "the combination of Znaiden with JP and WO results in a composition effective in melanin inhibition (skin lightening agents) due to kojic acid, arbutin and **effective in skin firming due to phytic acid and Vismia.**" Because not a single one of these references teaches either vismia or phytic acid in an amount effective for lightening skin, the combination of these references fails to teach or even suggest all claim limitations present in the currently pending claims as amended herein.

Based on the foregoing, applicants submit that the cited references do not render the present invention obvious within the meaning of 35 U.S.C. 103. Under this section, the prior art references when combined must teach or suggest all the claim limitations¹. The teaching or

¹ See MPEP 2143. ("To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the

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suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants submit that none of the references cited above, nor the combination of, teach all the limitations of the present and amended claims, nor do the references suggest modifying their teachings to arrive at applicant's invention.

For the reasons cited above, withdrawal of these rejections and allowance of all pending claims is respectfully requested.

claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 448, 20 USPQ2d 1438 (Fed. Cir. 1991)").

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CONCLUSION

The currently pending claims before the examiner are supported throughout the specification and are patentable over the prior art. No new matter has been added. Support for the amendments to claims 1-3, 12, 17, 19, and 20 can be found, for example, in paragraphs [0036], [0039], [0040], and [0083] ("to lighten skin"); and paragraphs [0053], [0065] and Examples 1-3 ("in an amount effective to lighten skin"). This application is now in full condition for allowance, and such action is respectfully requested.


The Commissioner is hereby authorized to charge any underpayment or credit any overpayment of fees under 37 C.F.R. 1.16 or 1.17 as required by this paper to Deposit Account 50-0951.

The examiner is cordially invited to call the undersigned if clarification is needed on any matter within this response, or if the examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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